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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,459	10/22/2003	Ajay R. Bam	65003/P002US/10312242	7339
29053 7590 12/07/2007 FULBRIGHT & JAWORSKI L.L.P 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784			EXAMINER MYHRE, JAMES W	
			ART UNIT 3622	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/691,459

Applicant(s)

BAM ET AL.

Examiner

James W. Myhre

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) 74 and 75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/03; 06/05; 04/06; 02/07.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the initial filing on October 22, 2003. Claims 1-75 are currently pending and have been considered below.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- a. It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.
- b. It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 25, 47, 59, 60, and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites the limitation "said electronic device" in line 2. There is insufficient antecedent basis for this limitation in the claim. The Examiner believes that the dependency of this claim is a typographical error and that the claim should depend upon either Claims 23 or Claim 24 (see Claim Objections paragraph below).

Claims 47, 59, and 60 include the acronyms DTMF, XML, and J2EE without first including their meaning in plain text as required.

Claim 65 recites the limitation "said wireless electronic device" in line 1. There is insufficient antecedent basis for this limitation in the claim. The Examiner believes that the dependency of this claim is a typographical error and that the claim should depend upon Claim 64 (see Claim Objections paragraph below).

Claim Objections

5. Claims 25 and 65 are objected to because of the following informalities:

Claims 25 and 65 appear to have typographical errors when identifying their parent claims. Based on the above identified lack of antecedent basis problems in

these claims, the Examiner will consider Claims 25 and 65 to depend upon Claims 24 and 64, respectively, when applying prior art below.

Appropriate correction is required.

Election/Restrictions

6. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-73, drawn to generating and redeeming promotions, classified in class 705, subclass 14.
 - II. Claims 74-75, drawn to verifying purchase payments, classified in class 705, subclass 75.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as purchase payments may be verified without generating or redeeming promotions. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a

continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kirby B. Drake on December 5, 2007 a provisional election was made without traverse to prosecute the invention of subcombination I, claims 1-73. Affirmation of this election must be made by applicant in replying to this Office action. Claims 74 and 75 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-63 and 66-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Narasimhan et al (6,237,145).

Claims 1, 3, 26, 30, 37, 55, 61, and 62: Narasimhan discloses a system, device, and method for distributing promotions, comprising:

- a. generating promotions for use by specific consumers (column 3, lines 28-35);
- b. transmitting the promotion data to an electronic device of a requesting consumer (column 4, lines 16-20 and column 7, lines 10-49); and
- c. applying the promotion to a purchase using the electronic device (column 7, line 50 – column 8, line 3).

Claim 13: Narasimhan discloses a method for redeeming promotions, comprising:

- a. accessing a promotion stored on a consumer's electronic device (column 4, lines 16-20 and column 7, lines 10-49);
- b. applying (redeeming) the promotion to a purchase (column 7, line 50 – column 8, line 3);

c. receiving a response from the consumer redeeming the promotion (column 6, lines 30-36 and column 7, lines 10-49); and

d. saving the redemption data in an electronic account (column 6, lines 30-36 and column 7, lines 10-49).

Claims 22, 23, 25, 41, 42, and 44: Narasimhan discloses a system and method for distributing a promotion, comprising:

- a. generating promotions for use by a consumer (column 3, lines 28-35);
- b. sending the promotion data to a consumer account (column 4, lines 16-20 and column 7, lines 10-49); and
- c. saving (storing) the promotion in the consumer account for later access and use by the requesting consumer (column 4, lines 16-20 and column 7, lines 10-48).

Claims 49 and 52-54: Narasimhan discloses a method for distributing a promotion, comprising:

- a. generating a promotion based on accessing a consumer profile database that includes consumer buying habits (column 4, lines 41-49);
- b. transmitting the promotion data to an electronic device of a requesting consumer (column 4, lines 16-20 and column 7, lines 10-49); and
- c. applying (redeeming) the promotion to a purchase (column 7, line 50 - column 8, line 3).

Claims 2, 14, and 50: Narasimhan discloses a method as in Claims 1, 13, and 49 above, and further discloses the promotion is a coupon, a discount, an alert, or an offer to sell (column 3, lines 28-35).

Claim 4: Narasimhan discloses a method as in Claim 3 above, and further discloses processing the redemption (inherently, according to established redemption rules) (column 7, lines 10-49).

Claims 5, 18, 36, 46, and 56: Narasimhan discloses a system, device, and method as in Claims 1, 13, 30, 41, and 55 above, and further discloses storing the promotion in an electronic account for later access by the consumer (column 4, lines 16-20 and column 7, lines 10-49).

Claims 6, 15, 24, and 43: Narasimhan discloses a system and method as in Claims 1, 13, 22, and 41 above, and further discloses the electronic device is a mobile device (smart card) (column 7, lines 10-49).

Claims 7, 8, and 21: Narasimhan disclose a method as in Claims 1 and 13 above, and further discloses the transmitted data (promotion) is a text or audio (voice) message (column 3, lines 28-35).

Claims 9, 16, and 33-35: Narasimhan discloses a method as in Claims 1, 13, and 30 above, and further discloses a promotion distributor generating the promotion based on a request from the consumer (column 3, lines 10-16 and column 8, lines 5-7).

Claims 10, 17, 27-29, 38-40, and 45: Narasimhan discloses a system and method as in Claims 1, 13, 26, 37, and 41 above, and further discloses generating the promotion based on the stored profile of the consumer/merchant (column 4, lines 41-49).

Claim 11: Narasimhan discloses a method as in Claim 1 above, and further discloses automatically applying the promotion during the purchase transaction (column 7, lines 10-49).

Claims 12 and 57: Narasimhan discloses a device and method as in Claims 1 and 55 above, and further discloses identifying the consumer by identifying the electronic device (smart card) (column 7, lines 10-49).

Claims 19 and 63: Narasimhan discloses a system and method as in Claims 13 and 62 above, and further discloses redeeming the promotion at a point of sale (POS) terminal (merchant device) using a payment method controlled by the consumer's electronic device (credit card) (column 7, lines 10-60).

Claim 20: Narasimhan discloses a method as in Claim 19 above, and further discloses automatically applying the promotion during the purchase transaction (column 7, lines 10-49).

Claims 31 and 32: Narasimhan discloses a method as in Claim 30 above, and further discloses that notifying consumers of promotions through the use of various types of advertisements (newspapers, television, etc.) was known well before the present invention (column 1, lines 23-55). Furthermore, no patentable weight is given as to why the consumer is requesting the promotion.

Claims 47, 48, and 58-60: Narasimhan discloses a system and device as in Claims 41 and 55 above, and further discloses utilizing an Internet or telephone interface (column 4, lines 9-15). No patentable weight is given to the type of protocol technology being used by these communication systems. It is inherent that each communication system would use compatible protocols, such as DTMF for telephones, XML or J2EE for computer networks (including the Internet), etc. based on the capabilities of the specific hardware and software being used by the communication system. The type of protocol being used would not affect, nor has the Applicant pointed out how any of them would affect, the steps being performed.

Claim 51: Narasimhan discloses a method as in Claim 49 above, and further discloses receiving a response from the consumer redeeming the promotion (column 6, lines 30-36 and column 7, lines 10-49).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan et al (6,237,145).

Claims 64 and 65: Narasimhan discloses a system as in Claim 61 above, but does not explicitly disclose that the consumer device is a wireless device, such as a cell phone. However, it is noted that there are two ways for entering and retrieving data from smart cards, such as the ones disclosed in Narasimhan. The first is electronic contacts in which one or more contacts must be brought into physical contact with corresponding contacts on a card reader. The second is wireless contacts in which infrared, light, or radio waves are used to transfer the data with no physical contact between the smart card and the card reader. Each contact method has its known advantages and disadvantages. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Narasimhan could use a contact or

contactless device for the consumer's device. Furthermore, it would have been obvious that any type of device with the appropriate input, output, and storage mechanisms could be used to include a credit card type of smart card, a cell phone, a personal data assistant (PDA), a pager, etc. One would have been motivated to use a wireless device, such as a cell phone, in order to eliminate the need for the customer to carry an additional device by combining multiple functions into one device. The Examiner further notes that little if any patentable weight is given to the type of other functions the device is able to perform, i.e. as to whether the device can also make telephone calls, access the Internet, play music, etc., since none of these other functions are being used in the claimed invention.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/691,459
Art Unit: 3622

Page 13

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JWM
December 5, 2007



James W. Myhre
Primary Patent Examiner